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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,805	02/08/2002	Mark Setteducati	1473	2847
4518	7590	03/22/2005	EXAMINER	
ROBERT W. J. USHER PATENT AGENT 1133 BROADWAY, #1515 NEW YORK, NY 10010			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/071,805	SETTEUCATI, MARK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dmitry Suhol	3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-18,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-10 and 18 is/are allowed.
- 6) ☒ Claim(s) 11-15 and 21 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claim 22 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 7-18, drawn to a deformable drawing tablet, classified in class 434, subclass 85.
- II. Claim 22, drawn to a method of forming a changeable image of a profile of a face of a character, classified in class 446, subclass 151.

Inventions of Group I and Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as the process of claim 22 without the step of moving the individual strips or a process where the amusement device is used as a drawing surface. Furthermore, the process for using the product as claimed can be practiced with another materially different product such as the product provided in claim 22 which does not require a cap member of claims 7 and 16, a holder for an implement of claims 8 and 17, a die of claim 9, or a drawing surface comprising a luminescent plastic material of claim 18.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 22 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Since this application contains claim 22 drawn to an invention nonelected due to original presentation. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Objections***

Claims 16 and 17 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 7 and 8, respectively, with the only difference being the wording of the preamble (i.e. "a deformable drawing tablet" vs. "an amusement device"). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

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one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 14, there is no antecedent basis for "the cap member".

Regarding claim 15, there is no antecedent basis for "the base member".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitney '627 in view of Lehr '798. Whitney discloses a deformable drawing tablet containing all of the elements of the claims including, a series of individual elongated strips extending horizontally (elements 2, where the horizontal orientation of the strips only depends upon which way the device is held or oriented) as required by claim 11,

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means concealed between the strips confining the strips together (element 3) as required by claim 11, an image carrying surface uninterrupted by the confining means as required by claim 11 is shown in figure 3, strips moving by sliding over each other through finger pressure (cols. 1-2, lines 49+ and 1-3, respectively) as required by claims 11 and 12, the strips being formed from longitudinally extending slots (figure 5) as required by claim 13, the confining means comprising a post extending transversely of said strips through said slots (element 3) in a longitudinally sliding relationship therewith (figure 5 and cols. 1-2, lines 49+ and 1-3, respectively) as required by claim 13. A cap member, as required by claims 13 and 14 is read onto elements 5 and 7. A base member, as required by claim 13 and 15, is read onto element 4.

Regarding an image of a profile of a character face as required by claim 11, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have incorporated a profile image of a character face in the orientation/positioning as claimed since Whitney clearly states at page 1, col. 2, lines 11-16 that a variety of images are encompassed with his device depending on the desired display information and the user of the device and since Lehr '798 discloses a device like that of Whitley which teaches that images on such devices may be oriented transversely to the moveable strips (see figures 1 and 3). Furthermore, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a

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specific type of picture display does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. profile of a face) and the substrate (e.g. strips of the amusement device) which is required for patentability.

Regarding the particular size of the amusement device as required by claim 21, it is considered that since Whitley does not put any limitations on his amusement device it would have been obvious to make his device of a size consistent with a key ring fob since the examiner takes official notice that amusement devices are often made with such sizes for the purpose of portability.

### ***Allowable Subject Matter***

Claims 7-10 and 18 are allowed.

### ***Response to Arguments***

Applicant's arguments filed 12/22/2004 have been fully considered but they are not persuasive. Applicants argue that since the strips of Whitley extend vertically they are unsuitable for forming a profile of a person's face and that the strips are not thin enough to provide sufficient continuity to construct a continuous profile of a person's face. In response the examiner points out that the strips of Whitley fit the definition of being vertical or horizontal as their orientation only depends upon which way the device is being held, however if applicants are saying that the strips can only be considered

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vertical due to the orientation of the image thereon then the examiner points out that it would have been obvious to change the orientation of Whitley's image (as shown by Lehr). With respect to the size of Whitley's strips it is the position of the examiner that his strips are small enough to fulfill the claimed functions since it would only depend on the size of the profile image to be displayed. In other words if the profile image is a large one then movements of strips 2 would not change the continuity of the profile image.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JESSICA HARRISON  
PRIMARY EXAMINER